

**REMARKS**

Claims 1-6, 8, 15-17, 87-88 and 90-92 are pending.

Claims 9-11, 18-86, and 89 are cancelled without prejudice.

Claim 1 is amended. Support for the amendment to this claim is found in the application as originally filed, specifically in Fig. 1, and on page 16, lines 5-20.

No new matter is added.

**Rejection of claims under 35 U.S.C. § 103 – Orlando in view of Schena**

Claims 1-6, 8, 10, 11, 17-22, 39-43, 45, 48-53, 56-59, 61, 64-68, 71-76 and 78-84 and 87-92 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Orlando (Methods 1997 11:205-214) in view of Schena (Tibtech (1998) 16:301-306).

In an attempt to establish this rejection, the Examiner argues that Orlando's immunoprecipitation-based methods, in combination with Schena's array, render the instant claims unpatentable. This rejection is respectfully traversed.

The rejected claims recite the use of an array containing sequences that detect intergenic regions. Further, the rejected claims recite a method in which a second portion of a sample is labeled and used as a control.

The disclosures of Orlando and Schena are completely void of any discussion of arrays that contain sequences that detect intergenic regions. Likewise, the disclosures of Orlando and Schena do not mention any method in which a second portion of a sample is labeled and used as a control. As such, the references cited in this rejection, taken independently or in any combination, fail to disclose or reasonably suggest each and every element of the rejected claims.

This rejection may be withdrawn for this reason alone.

The Applicants further note that the disclosures of Orlando and Schena, combined in the manner proposed in this Office Action, would result in a method in which the transcription factor binding is compared between two distinct samples. This is *not* the method being claimed and, as such, this rejection should be withdrawn.

The Applicants submit that this rejection has been adequately addressed.  
Withdrawal of this rejection is respectfully requested.

**Rejection of claims under 35 U.S.C. § 103 – Orlando in view of Schena**

Claims 1-6, 8-11, 15-22, 25, 26, 28-36, 39-53, 56-59, 61-68, 71-84 and 87-92 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mercola (USPN 6,410,233) in view of Schena.

In an attempt to establish this rejection, the Examiner argues that Mercola's immunoprecipitation-based methods, in combination with Schena's array, render the instant claims unpatentable. This rejection is respectfully traversed.

The rejected claims recite the use of an array containing sequences that detect intergenic regions. Further, the rejected claims recite a method in which a second portion of a sample is labeled and used as a control.

The disclosures of Mercola and Schena are completely void of any explicit discussion of arrays that contain sequences that detect intergenic regions. Likewise, the disclosures of Mercola and Schena do not explicitly mention any method in which a second portion of a sample is labeled and used as a control. As such, the references cited in this rejection, taken independently or in any combination, fail to disclose or reasonably suggest each and every element of the rejected claims.

This rejection may be withdrawn for this reason alone.

The Applicants further note that the disclosures of Mercola and Schena, combined in the manner proposed in this Office Action, would result in a method in which the transcription factor binding is compared between two distinct samples. This is *not* the method being claimed and, as such, this rejection should be withdrawn.

The Applicants submit that this rejection has been adequately addressed.  
Withdrawal of this rejection is respectfully requested.

**Rejection of claims under 35 U.S.C. § 103 – Orlando in view of Schena and Hacia**

Claims 9, 15, 16, 25, 26, 28-36, 46, 47, 62, 63, 77 and 78 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Orlando in view of Schena and Hacia (Nucleic Acids Research (1998) 26(16):3865-3866).

In an attempt to establish this rejection, the Examiner argues that Orlando's immunoprecipitation-based methods, in combination with Schena's array and Hacia's cyanine dyes, render the instant claims unpatentable. This rejection is respectfully traversed.

The rejected claims recite the use of an array containing sequences that detect intergenic regions. Further, the rejected claims recite a method in which a second portion of a sample is labeled and used as a control.

The disclosures of Orlando, Schena and Hacia are completely void of any explicit discussion of arrays that contain sequences that detect intergenic regions. Likewise, the disclosures of Orlando, Schena and Hacia do not explicitly mention any method in which a second portion of a sample is labeled and used as a control. As such, the references cited in this rejection, taken independently or in any combination, fail to disclose or reasonably suggest each and every element of the rejected claims.

This rejection may be withdrawn for this reason alone.

The Applicants further note that the disclosures of Orlando, Schena and Hacia, combined in the manner proposed in this Office Action, would result in a method in which the transcription factor binding is compared between two distinct samples. This is *not* the method being claimed and, as such, this rejection should be withdrawn.

The Applicants submit that this rejection has been adequately addressed. Withdrawal of this rejection is respectfully requested.

**Rejection of claims under 35 U.S.C. § 103 – Orlando in view of Schena, Hacia and Hallahan**

Claims 23, 24, 37, 38, 54, 55, 69, 70, 85 and 86 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Orlando in view of Schena, Hacia and Hallahan (J. Biol. Chem 1995 270:30303-9).

Without any intention to acquiesce to the correctness of this rejection, these claims have been cancelled and, as such, this rejection is now moot.

**Rejection of claims under 35 U.S.C. § 103 – Mercola in view of Schena and Hacia**

Claims 23, 24, 37, 38, 54, 55, 69, 70, 85 and 86 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Mercola '233 patent in view of Mercola in view of Schena and Hallahan.

Without any intention to acquiesce to the correctness of this rejection, these claims have been cancelled and, as such, this rejection is now moot.

**CONCLUSION**

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone John Brady at (408) 553-3584.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10050560-1.

Respectfully submitted,  
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